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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/814,058

03/30/2004

Kak-Shan Shia

15551-003001

5712

69713 7590 12/13/2007
OCCHIUTI ROHLICEK & TSAO, LLP
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EXAMINER

HENLEY III, RAYMOND J

ART UNIT

PAPER NUMBER

1614

MAIL DATE

DELIVERY MODE

12/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,058

Applicant(s)

SHIA ET AL.

Examiner

Raymond J. Henley III

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2007 and 04 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-57 is/are pending in the application.
- 4a) Of the above claim(s) 30-39, 41-46 and 48-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 29, 40 and 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/19/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

CLAIMS 29-57 ARE PRESENTED FOR EXAMINATION

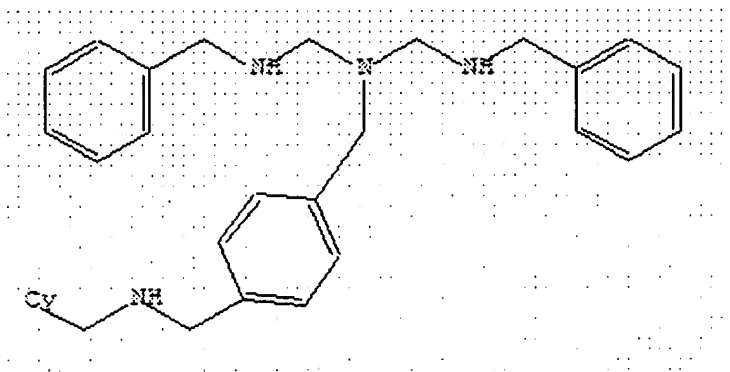
Applicants' amendment filed September 4, 2007 and Information Disclosure Statement filed November 19, 2007 have been received and entered into the application. Accordingly, claims 1-28 have been canceled. Also, as reflected by the attached, completed copy of form PTO-1449, (1 sheet), the cited references have been considered.

In light of Applicants' remarks, the claim rejections under 35 U.S.C. §§ 112, second paragraph and 103, as set forth in the previous Office action have been overcome and thus are here withdrawn

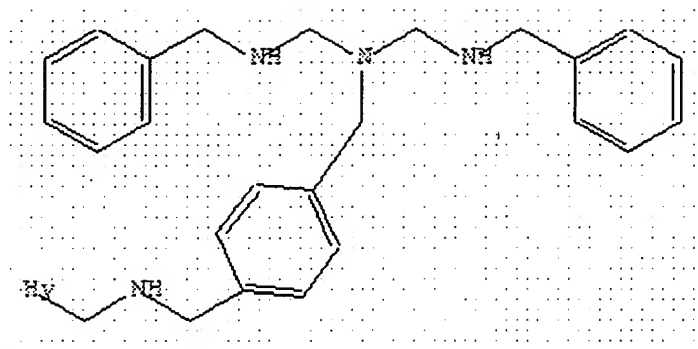
Claims 30-39, 41-46 and 48-57 remain withdrawn as being directed to non-elected subject matter (37 C.F.R. 1.142).

Claim Objection

Applicants' elected species, encompassed by claims 29, 40 and 47, would be allowable if presented as an independent claim. The Examiner has extended his consideration and search to encompass a reasonable group of species having at least the following cores:



and



These generic structures were used substantially as a search term. In the above structures, "Cy" is a carbocyclic ring, saturated or unsaturated, non-isolated, carbon-ring moiety unrestricted as to the size of the ring. The term "non-isolated" means that it allows for additional substituents to be present. Also, "Hy" is a variable that includes any group having a heterocyclic group. Compounds having the above cores were not found to be taught or suggested in the art and thus, if the claims were as limited, (i.e., employing Applicants' variable designations), those claims would be in condition for allowance.

Claims 29, 40 and 47 are objected to as being directed to an unreasonable number of additional species and should be limited, using Applicants' specification as a definition guide, to a genus of compounds having at least the above recited cores.

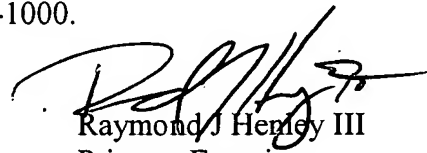
None of the claims are currently in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Henley III whose telephone number is 571-

272-0575. The examiner can normally be reached on M-F, 8:30 am to 4:00 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Raymond J. Henley III
Primary Examiner
Art Unit 1614

December 7, 2007